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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,117	02/15/2000	Hiroyuki Yamamoto	105311	7485

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/504,117

Applicant(s)

YAMAMOTO, HIROYUKI

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/9/04, and has been entered and made of record. Currently, **claims 1-27** are pending.

Drawings

2. The drawings were received on 6/9/04. These drawings are acceptable by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1, 2, 5-7, 10-12, 15-17, 20, 21, and 24-27** are rejected under 35 U.S.C. 102(b) as being anticipated by Kulakowski (WIPO Publication Number WO 97/10668).

Regarding *claim 1*, Kulakowski discloses a communication apparatus (interface 10, seen in Figs. 1-3) that transmits to a receiver, image information with transmission information attached to a part of the image information, via a communication line (see abstract, and Figs. 1 and 5), comprising an address inputting device that inputs address information of the receiver (page 12, lines 5 through 14), a setting device that sets an attachment or a non-attachment of the transmission information based on the address information (page 13, line 1 through page 14, line

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19, and page 15, lines 18 through 35), a storage device that stores the address information for which the attachment/non-attachment of the transmission information is set (memory 34, page 12, line 33 through page 13, line 10), a transmission information attaching device that attaches/does not attach the transmission information to the image information, based on the address information stored in the storage device (page 13, line 1 through page 14, line 19, and page 15, lines 18 through 35), and a transmission device that transmits the image information with/without the transmission information attached thereto by the transmission information attaching device (page 15, lines 1 through 35), wherein the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (page 14, lines 1 through 14, see Fig. 4).

Regarding *claim 2*, Kulakowski discloses the apparatus discussed above in claim 1, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (page 12, line 5 through page 13, line 10, and page 14, lines 1 through 19).

Regarding *claim 5*, Kulakowski discloses the apparatus discussed above in claim 1, and further teaches of a changing device that temporarily changes the transmission information attachment/non-attachment setting made for the address information (page 14, lines 1 through 19).

Regarding *claim 6*, Kulakowski discloses a communication apparatus (interface 10, seen in Figs. 1-3) capable of transmitting image information with transmission information attached to a part of the image information to a receiver, via a communication line (see abstract, and Figs. 1 and 5), comprising an address inputting device that inputs address information of the receiver

(page 12, lines 5 through 14), and a transmission information attaching device that attaches the transmission information to a part of the image information (page 13, line 1 through page 14, line 19), wherein the transmission information attaching device selectively determines the attachment/non-attachment of the transmission information according to the address information (page 13, line 1 through page 15, line 35), and the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (page 14, lines 1 through 14, see Fig. 4).

Regarding *claim 7*, Kulakowski discloses the apparatus discussed above in claim 6, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (page 12, line 5 through page 13, line 10, and page 14, lines 1 through 19).

Regarding *claim 10*, Kulakowski discloses the apparatus discussed above in claim 6, and further teaches of a changing device that temporarily changes the transmission information attachment/non-attachment setting made for the address information (page 14, lines 1 through 19).

Regarding *claim 11*, Kulakowski discloses a communication apparatus (interface 10, seen in Figs. 1-3) capable of transmitting image information with transmission information attached to a part of the image information to a receiver, via a communication line (see abstract, and Figs. 1 and 5), comprising an address inputting device that inputs address information of the receiver (page 12, lines 5 through 14), a setting device that sets an attachment or a non-attachment of the transmission information according to the address information (page 13, line 1 through page 14, line 19, and page 15, lines 18 through 35), and a transmission information attaching device that

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attaches the transmission information to a part of the image information (page 13, line 1 through page 14, line 19), wherein the transmission information attaching device selectively determines the attachment/non-attachment of the transmission information based on the address information (page 13, line 1 through page 15, line 35), and the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (page 14, lines 1 through 14, see Fig. 4).

Regarding *claim 12*, Kulakowski discloses the apparatus discussed above in claim 11, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (page 12, line 5 through page 13, line 10, and page 14, lines 1 through 19).

Regarding *claim 15*, Kulakowski discloses the apparatus discussed above in claim 11, and further teaches of a changing device that temporarily changes the transmission information attachment/non-attachment setting made for the address information (page 14, lines 1 through 19).

Regarding *claim 16*, Kulakowski discloses a communication apparatus (interface 10, seen in Figs. 1-3) capable of transmitting image information with transmission information attached to a part of the image information to a receiver, via a communication line (see abstract, and Figs. 1 and 5), comprising an address inputting device that inputs address information of the receiver (page 12, lines 5 through 14), a setting device that sets an attachment/non-attachment of the transmission information (page 13, line 1 through page 14, line 19, and page 15, lines 18 through 35), a changing device that changes the transmission information attachment/non-attachment setting made by the setting device (page 14, lines 1 through 19), a transmission information

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attaching device that attaches/does not attach the transmission information to a part of the image information, based on the setting made by the setting device and the result of change made by the changing device (page 12, lines 5 through 14, page 13, line 1 through page 14, line 19, and page 15, lines 18 through 35), and a transmission device that transmits to the receiver the image information, according to the address information input by the address inputting device, wherein the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (page 14, lines 1 through 14, see Fig. 4).

Regarding *claim 17*, Kulakowski discloses the apparatus discussed above in claim 16, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (page 12, line 5 through page 13, line 10, and page 14, lines 1 through 19).

Regarding *claim 20*, Kulakowski discloses a communication apparatus (interface 10, seen in Figs. 1-3) capable of transmitting image information with transmission information attached to a part of the image information to a receiver, via a communication line (see abstract, and Figs. 1 and 5), comprising an address inputting device that inputs address information of the receiver (page 12, lines 5 through 14), a storage device that stores at least one piece of the receiver's address information input by the address inputting device (memory 34, page 12, line 33 through page 13, line 10), a determination device that determines whether the address information of the receiver to whom the image information is transmitted, is address information stored in the storage device or address information newly input via the address inputting device (page 13, line 1 through page 14, line 19, and page 15, lines 18 through 35), a transmission information attaching device that attaches/does not attach the transmission information to a part of the image

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information, based on the determination result made by the determination device (page 13, line 1 through page 14, line 19, and page 15, lines 18 through 35), and a transmission device that transmits to the receiver the image information, according to the receiver's address information (page 15, lines 1 through 35), wherein the transmission information includes information of at least one of a transmitter, date and time of transmission, and a number of transmitted pages (page 14, lines 1 through 14, see Fig. 4).

Regarding **claim 21**, Kulakowski discloses the apparatus discussed above in claim 20, and further teaches that the address information includes a receiver's mail address having an account name and a domain name (page 12, line 5 through page 13, line 10, and page 14, lines 1 through 19).

Regarding **claim 24**, Kulakowski discloses the apparatus discussed above in claim 20, and further teaches of a changing device that temporarily changes the transmission information attachment/non-attachment setting made for the address information (page 14, lines 1 through 19).

Regarding **claim 25**, Kulakowski discloses a communication apparatus (interface 10, seen in Figs. 1-3) capable of transmitting image information with transmission information attached to a part of the image information to a receiver, via a communication line (see abstract, and Figs. 1 and 5), comprising an address inputting device that inputs address information of the receiver (page 12, lines 5 through 14), and a transmission information attaching device that attaches the transmission information along an outside border of the image information (page 13, line 1 through page 14, line 19, see Fig. 4), wherein the transmission information attaching device

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selectively determines the attachment/non-attachment of the transmission information according to the address information (page 13, line 1 through page 15, line 35).

Regarding *claim 26*, Kulakowski discloses the apparatus discussed above in claim 25, and further teaches that transmission information is attached along at least one of a top border and a bottom border of the image information (see Fig. 4).

Regarding *claim 27*, Kulakowski discloses the apparatus discussed above in claim 25, and further teaches that transmission information is attached to each page of the image information (see Fig. 4, page 14, lines 1 through 19).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3, 4, 8, 9, 13, 14, 18, 19, 22, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski (WIPO Publication Number WO 97/10668) in view of Eguchi (U.S. Patent Number 6,574,670, cited in the Office action dated 3/11/04).

Regarding *claims 3, 4, 8, 9, 13, 14, 18, 19, 22, and 23*, Kulakowski discloses the apparatus discussed above in claims 2, 7, 12, 17, and 21, respectively, but fails to expressly disclose of a receiver's domain name designation device that designates the domain name of the receiver, wherein the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted, according to the

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conformance/non-conformance of the receiver's domain name in the address information input via the address inputting device, to the receiver's domain name designated via the receiver's domain name designation device, as required in claims 3, 8, 13, 18, and 22. Further, with respect to claims 4, 9, 14, 19, and 23, Kulakowski fails to expressly disclose that the communication apparatus has a transmitter's mail address having an account name and a domain name and the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted, according to the conformance/non-conformance of the transmitter's domain name to the receiver's domain name.

Eguchi discloses a communication apparatus (facsimile machine F, seen in Fig. 3, or facsimile machines 41, 42, 43, seen in Fig. 4) that transmits to a receiver, image information with transmission information attached to a part of the image information, via a communication line (see abstract, column 8, lines 25 through 43, and column 10, line 63 through column 11, line 21), comprising an address inputting device that inputs address information of the receiver (column 8, lines 3 through 7, and column 10, line 63 through column 11, line 13), a setting device that sets an attachment or a non-attachment of the transmission information based on the address information (column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 13), a storage device that stores the address information for which the attachment/non-attachment of the transmission information is set (RAM 8, column 5, lines 62 through 67, and column 7, lines 50 through 59), a transmission information attaching device that attaches/does not attach the transmission information to the image information, based on the address information stored in the storage device (see abstract, column 6, lines 52 through 67, column 8, lines 8 through 18, and column 10, line 63 through column 11, line 9), and a

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transmission device that transmits the image information with/without the transmission information attached thereto by the transmission information attaching device (see abstract, column 6, lines 35 through 67, and column 8, lines 8 through 24).

Continuing, Eguchi teaches that the address information includes a receiver's mail address having an account name and a domain name (see Figs. 2b, 2c, 7b, and 7c, column 7, lines 16 through 29, and column 8, line 58 through column 9, line 28). Further, Eguchi teaches of a receiver's domain name designation device that designates the domain name of the receiver (column 7, lines 17 through 59), wherein the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted (column 6, lines 58 through 67, and column 8, lines 3 through 18), according to the conformance/non-conformance of the receiver's domain name in the address information input via the address inputting device, to the receiver's domain name designated via the receiver's domain name designation device (column 7, line 62 through column 8, line 18, and column 10, line 63 through column 11, line 21). Continuing, Eguchi teaches that the communication apparatus has a transmitter's mail address having an account name and a domain name (see Figs. 2a and 7a, column 7, lines 10 through 16, and column 9, lines 4 through 10) and the transmission information attaching device selectively attaches/does not attach the transmission information to the image information to be transmitted, according to the conformance/non-conformance of the transmitter's domain name to the receiver's domain name (column 7, line 62 through column 8, line 43).

Kulakowski & Eguchi are combinable because they are from the same field of endeavor, being systems that transmit scanned documents as e-mail data.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the teachings Eguchi in the system of Kulakowski.

The suggestion/motivation for doing so would have been that Kulakowski's system would include simplified operations with the addition of Eguchi's teachings, as transmission information would be attached according to the conformance of the input receiver's domain name, thus allowing different providers and access points, as well as different networks to be easily utilize, as recognized by Eguchi in columns 1 and 2.

Therefore, it would have been obvious to combine the teachings of Eguchi with the system of Kulakowski to obtain the invention as specified in claims 3, 4, 8, 9, 13, 14, 18, 19, 22, and 23.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

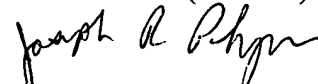
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph R. Pokrzywa
Examiner
Art Unit 2622

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